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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: YEVGENY YAKOV (GENE) ITKIS

Serial No.: 09/502,867

Group No.: 2766

Filed: February 11, 2000

Examiner.: --

For: KEY MANAGEMENT FOR CONTENT PROTECTION

Attorney Docket No.: U 013182-7

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Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

INFORMATION DISCLOSURE STATEMENT

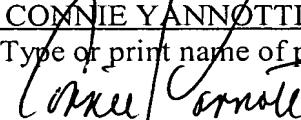
We draw the attention of the Examiner to the attached references which are also listed on the attached Form PTO-1449.

Respectfully submitted,

  
WILLIAM R. EVANS  
c/o Ladas & Parry  
26 West 61<sup>st</sup> Street  
New York, New York 10023  
Reg. No. 25,858 (212) 708-1930

CERTIFICATE UNDER 37 CFR 1.10

I hereby certify that this paper is being deposited with the United States Postal Service on this date January 27, 2003 in an envelope as "EXPRESS MAIL POST OFFICE TO ADDRESSEE" Mailing Label Number EV011026255US addressed to the: Assistant Commissioner of Patents and Trademarks, Washington, D.C. 20231

CONNIE YANNOTTI  
(Type or print name of person mailing paper)  
  
(Signature of person mailing paper)

NOTE: Each paper or fee referred to as enclosed herein has the number of the "EXPRESS MAIL" mailing label place thereon prior to mailing 37 CFR 1.16(b).



01-28-03

2766  
2131

Practitioner's Docket No. U 013182-7

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application  
of

Inventor(s)

for

Title of invention

OR

In re application of: YEVGENY YAKOV (GENE) ITKIS

Serial No.: 09/502,867

Group No.: 2766

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Examiner.: --

For: KEY MANAGEMENT FOR CONTENT PROTECTION

Assistant Commissioner for Patents  
Washington, D.C. 20231

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT  
WITHIN THREE MONTHS OF FILING OR  
BEFORE MAILING OF FIRST OFFICE ACTION (37 C.F.R. 1.97(b))**

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**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***

*(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

**37 C.F.R. 1.8(a)**

**37 C.F.R. 1.10\***

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as "Express Mail Post Office to Addressee"  
Mailing Label No. EV011026255US (mandatory)

**TRANSMISSION**

transmitted by facsimile to the Patent and Trademark Office.

Date: January 27, 2003

**Signature**

**CONNIE YANNOTTI**

*(type or print name of person certifying)*

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

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NOTE: 37 C.F.R. 1.98(b):

- (1) *Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.*
- (2) *Each U.S. patent application published listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.*
- (3) *Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.*
- (4) *Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.*
- (5) *Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.*

**WARNING:**

*No extension of time can be had under 37 C.F.R. § 1.36 (a) or (b) for filing an IDS. 37 C.F.R. § 1.97(j).*

NOTE: The "filing date of a national application" under 37 C.F.R. 1.97(b) has two possible meanings. Where the filing is a direct one to the United States Patent & Trademark office, the filing is defined in 37 C.F.R. 1.53(b) as "the date on which: (1) A specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41." 37 C.F.R. 1.97(b)(1). On the other hand, an international application that enters the national stage occurs when the applicant has filed the documents and fees required by 35 U.S.C. § 371(c) within the periods set forth in § 1.494 or § 1.495. 35 U.S.C. § 371(c) requires the filing of the following: (1) the national fee; (2) a copy of the international application, unless already sent by the International Bureau, and an English translation if filed in another language; (3) amendments under PCT Article 19, with a translation into English if made in another language; (4) an oath or declaration; and (5) a translation into English of any annexes to the international preliminary examination report, if such annexes were made in another language. 37 C.F.R. 1.97(b)(2).

### **IDENTIFICATION OF TIME OF FILING THE ACCOMPANYING INFORMATION DISCLOSURE STATEMENT**

The information disclosure statement submitted herewith is being filed within three months of the filing date of the application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever event occurs last. 37 C.F.R. 1.97(b).

NOTE: "No certification or fee is due when the filing is made within the above time period. It is advisable to ensure that no Office action has been mailed if the disclosure statement is delayed until after three months from filing."

NOTE: "An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of a mailing if accompanied by a properly executed certificate of mailing under 37 C.F.R. 1.8, or Express Mail certificate under 37 C.F.R. 1.10. An office action is mailed on the date indicated in the Office action." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "The term 'national application' includes continuing applications (continuations, divisions, continuations-in-part) so three-months will be measured from the actual filing date of an application as opposed [sic] to the effective date of a continuing application." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**NOTE:** "An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirements (37 C.F.R. 1.142) or just a requirement for additional fees to have a claim considered (37 C.F.R. 1.16(d)). Thus, if an application was filed on Jan. 1 and the first Office action on the merits was not mailed until six months later on July 1, the examiner would be required to consider any proper information disclosure statement filed prior to July 1." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**WARNING:** "A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63).



**SIGNATURE OF PRACTITIONER**

Reg. No. 25,858

**WILLIAM R. EVANS**

*(type or print name of practitioner)*

Tel. No.: (212) 708-1930

**P.O. Address**

Customer No.: 00140

c/o Ladas & Parry  
26 West 61<sup>st</sup> Street  
New York, N.Y. 10023



Practitioner's Docket No. U 013182-7

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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For: KEY MANAGEMENT FOR CONTENT PROTECTION

Group No.: 2766

Examiner.: --

**Assistant Commissioner for Patents**  
**Washington, D.C. 20231**

**STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. SECTION 1.97(e)**

**NOTE:** *A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. Section 1.97(e).*

*Under the first statement under § 1.97(e), it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. See § 609B(5), M.P. E. P., 8<sup>th</sup> Edition.*

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**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***  
(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

**37 C.F.R. 1.8(a)**

with sufficient postage as first class mail.

**37 C.F.R. 1.10\***

as "Express Mail Post Office to Addressee"  
Mailing Label No. EV011026255US (mandatory)

**TRANSMISSION**

transmitted by facsimile to the Patent and Trademark Office.

Date: January 27, 2003

**Signature**

**CONNIE YANNOTTI**

(type or print name of person certifying)

*\* Only the date filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continue to be taken into account in determining timeliness. See § 1.703(j). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.*

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**NOTE:** "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

**NOTE:** "The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. 1.10." See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

**NOTE:** "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition:

"If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement."

**NOTE:** A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

**NOTE:** "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

**NOTE:** "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

**NOTE:** The mere absence of an item of information for a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).

**NOTE:** The IDS is considered filed as of the date it is received in the PTO, or on an earlier date of mailing of

*transmission if done so with a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. § 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. § 1.10. See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.*

**NOTE:** *"The certification under Section 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.*

**NOTE:** *"The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

**NOTE:** *"Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and*

*"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:*

- (1) each inventor named in the application;*
- (2) each attorney or agent who prepares or prosecutes the application; and*
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. Section 1.56(c).*

#### **IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS STATEMENT IS BEING MADE**

1. This statement is being made for the Information Disclosure Statement

accompanying this statement.  
[ ] filed \_\_\_\_\_.

Date

#### **STATEMENT**

2. I, the person(s) signing below state:

that each item of information contained in the information disclosure statement was **first** cited in a communication (**copy attached**) from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

**NOTE:** *The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

#### **OR**

that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

**NOTE:** "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

### **IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT**

3. The person making this statement is

*(check each applicable item)*

(a)  the inventor(s) who signs below

---

#### **SIGNATURE OF INVENTOR**

---

*(type name of inventor who is signing)*

(b)  a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

---

#### **SIGNATURE OF PERSON MAKING STATEMENT**

---

*(type name of person who is signing)*

Address of person who is signing

---

(c)  the practitioner who signs below on the basis of the information:

*(check each applicable item)*

supplied by the inventor(s).  
 supplied by an individual designated in Section 1.56(c).  
 in the practitioner's file.

---

#### **SIGNATURE OF PRACTITIONER**

---

**WILLIAM R. EVANS**

*(type or print name of practitioner)*

Reg. No. 25,858

Tel. No. (212) 708-1930

P.O. Address

Customer No.: 00140

c/o Ladas & Parry  
26 West 61<sup>st</sup> Street  
New York, N.Y. 10023

מדינת ישראל

חוק הפטנטים, תשכ"ז - 1967

משרד המשפטים  
רשם הפטנטים  
לשכת הפטנטים

תאריך : 10.12.2002  
מספרם : 34543

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JAN 30 2003  
Technology Center 2100

לכבוד  
סנפורד ט. קולב ושות', עו"פ

א.ג.ג.,

הندון : הודעה על ליקויים בבקשת פטנט מס' 130963

מכתבך מיום : 30.10.2002

בהתאם להוראות תקנה 41 לתקנות הפטנטים (נווהי הלשכה סדרי דין, מסמכים ואגרות),  
התשכ"ח - 1968, הנוי להודיעכם כי נמצאו בבקשת הליקויים המפורטים להלן.  
עליכם לחשב על הדעה וتخاذ אربעה חדשניים מתאריכה, אך הנכם רשאים לבקש את הארכת התקופה.  
עם בקשה כאמור, שתוגש לפני תום התקופה, יש שלם אגרה בסך 53 ש"ח بعد כל חדש או חלק ממנו.

ואלה הליקויים :

1. תשובתכם הנ"ל היא תשובה לפי סעיף 18(2) לחוק. יש גם צורך לענות לפי סעיף 18(1) לחוק  
כידוע לכם.
2. התביעה 22 מأد כללית.
3. התביעות 1 ו- 22 מורות על 2 אמצעות שונות בנגדם לסעיף 8 לחוק.
4. אין התקדמות המצאתית בתביעות 1, 22 לאור המתוואר בפטנטים מס' US 5889863, US 5892900, US 5550575

רצוף : ציטוטים

